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Aaron M. Lamstein

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Bay Area Technolgy Law Group PC
500 Sansome Street, Suite 404
San Francisco, CA 94111

EXAMINER

VALENTI, ANDREA M

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/801,240
Filing Date: March 15, 2004
Appellant(s): LAMSTEIN, AARON M.

Nathan P. Koenig
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 25 March 2010 appealing from the Office action mailed 08 January 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-9 are finally rejected and are being appealed.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,305,318	Ford	10-2001
6,435,133	Wayne	08-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,305,318 to Ford in view of U.S. Patent No. 6,435,133 to Wayne.

Regarding Claim 1, Ford teaches a pet bed for use by cats (Col. 1 line 11), said pet bed comprising a resilient, compressible fill material (#13), and an outer shell fabric (#2) defining the geometry of the pet bed as having a bottom and sides and a top, the later comprising a gas permeable fabric (Col. 2 line 24-29), a closable opening in said outer shell fabric allowing for selective access to the interior of said outer shell fabric

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(Fig. 2 #9), a gas permeable pouch (#19) containing catnip located beneath said top fabric such that scent from said catnip is caused to permeate through the said gas permeable pouch and gas permeable top fabric.

Ford is silent on explicitly teaching that the catnip pouch is located within the closable opening. However, merely shifting the location of a known element performing the same intended function of providing a removable scent that attracts cats, shifted for the motivation to prevent easy access by the animal, does not present a patentably distinct limitation over the prior art of record [*In re Japikse*, 181 F.2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950)].

Ford teaches a canvas-like fabric (Ford denim Col. 2 line 28), but is silent on explicitly teaching a plush fabric. However, Wayne teaches a pet bed for use by cats that has a plush fabric surface (Wayne Col. 3 line 29 and Col. 4 line 7-8). Wayne teaches it is known to substitute a plush fabric for a canvas-like fabric. It would have been obvious to one of ordinary skill in the art to modify the teachings of Ford with the teachings of Wayne at the time of the invention to create a more comfortable bed for the animal. The modification is merely the selection of a known alternate material for intended use [Leshin 125 USPQ 416] to obtain predictable results.

Regarding Claim 2, Ford as modified teaches the said gas permeable pouch (#19) containing catnip is located between said resilient compressible fill material and said top fabric (Fig. 5) and in contact with the resilient fill material (Ford as modified with #19 within #9).

Regarding Claims 8 and 9, Ford as modified teaches that the top fabric and pouch materials are sufficiently permeable (Ford Col.2 line 60-65) such that inherently teaches that said top fabric is depressed by the weight of the cat using said pet bed, scent from said catnip is caused to permeate through said gas permeable pouch and gas permeable top surface or when said gas permeable pouch is squeezed, scent from said catnip is caused to permeate through said gas permeable pouch and gas permeable top surface occurs when the animal is present on top of the bed.

Regarding Claim 3, Ford as modified is silent on the gas permeable pouch containing catnip is located beneath said resilient compressible fill material and thus separated from the top by the resilient compressible fill material. However, it would have been obvious to one of ordinary skill in the art to modify the teachings at the time of the invention since the modification is merely the shifting location of a known element, for ease of assembly or desired attractive powers, performing the same intended function and does not present a patentably distinct limitation [*In re Japikse*, 181 F.2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950)]. Furthermore, applicant has not claimed the orientation of the bed; therefore, if the bed got turned upside down the catnip inherently would be located under the fill material. Thus it is merely a relative limitation to the orientation of the pillow

Regarding Claims 5 and 7, Ford as modified teaches the gas permeable pouch is attached to an interior surface of said top fabric by providing said interior surface with a fabric pocket sized to receive said pouch (Fig. 5); Ford as modified by placing #19 within #9 and closing; merely making a known component integral to prevent

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displacement does not present a patentably distinct limitation over the prior art of record [In re Larson, 340 F.2d 965, 967, 144 USPQ 347, 349 (CCPA 1965)].

Regarding Claim 6, Ford as modified teaches that hook and loop fasteners are a known means of securing things in place (#9), but is silent on said gas permeable pouch is attached to an interior surface of said top fabric by hook-and-loop fasteners. However, it would have been obvious to one of ordinary skill in the art to modify the teachings of Ford at the time of the invention with a known fastening means to prevent the catnip from becoming undesirably displaced. [In re Larson, 340 F.2d 965, 967, 144 USPQ 347, 349 (CCPA 1965)].

Regarding Claim 4, Ford as modified is silent on said gas permeable pouch is characterized as having a closable opening so that catnip can be periodically refillably introduced to said pouch. However, it is old and notoriously well-known to provide recyclable pouches as an environmentally sound practice to reduce waste. It would have been obvious to one of ordinary skill in the art to modify the teachings at the time of the invention for the cost reducing and environmentally beneficial results.

(10) Response to Argument

Applicant argues that Ford does not teach placing a catnip pouch beneath gas permeable fabric and does not provide a closable opening for the catnip pouch in the outer shell of the fabric. The examiner maintains the previous response and reiterates that it is the examiner's position that Ford teaches a closable opening around the waistband (Ford Fig. 2 #9 and Col.2 line 36-42). Ford does teach the concept of placing the gas permeable pouch beneath the top fabric (Ford Fig.5 #19) since Ford places the

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pouch in a pocket. The top surface of the pocket is considered to be part of the top fabric of the bed since the pocket is constructed out of the material that is identical to the material covering the fill material. In other words, by being in the pocket of Ford, the pouch is under the top fabric i.e. beneath gas permeable fabric. Ford is silent on explicitly teaching that the catnip pouch is located within the closable opening.

However, it is the examiner's position that merely moving the catnip from one pocket opening to another pocket opening is merely shifting the location of a known element performing the same intended function of providing a removable scent that attracts cats, shifted for the motivation to prevent easy access by the animal, and does not present a patentably distinct limitation over the prior art of record [*In re Japikse*, 181 F.2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950)]. The modification is merely an obvious re-arrangement of known parts performing the same intended function.

Furthermore, the modification of shifting the location of the catnip pouch could be viewed merely as "obvious to try" choosing from a finite number of identified, predictable solutions with a reasonable expectation of success.

Applicant argues that Ford does not teach placing the gas permeable pouch containing catnip between the resilient fill material or beneath the compressible fill material and the top fabric. However, the examiner maintains that Ford teaches a resilient compressible fill material (Ford Col. 2 line 57-59) and a shell fabric (Ford Col. 2 line 25-27 element #2). Ford as modified satisfies all the limitations of all the claims. In claim 3, applicant has merely claimed the catnip is located beneath the fill material. Applicant has not claimed the orientation of the bed; therefore, if the bed got turned

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upside down the catnip inherently would be located under the fill material. Thus it is merely a relative limitation to the orientation of the pillow.

The examiner has not ignored the limitation that the catnip pouch is retained within a closable opening in the outer shell fabric. It is the examiner's position that Ford teaches a pet bed made up of an outer shell fabric with a closable opening around the waistband and a resilient fill material inside. Ford teaches securing a catnip pouch to the pet bed and more explicitly actually underneath a layer of the outer shell fabric (i.e. the pocket), but is merely silent about placing the pouch inside the closable opening of the outer shell. Merely shifting the location of a known component performing the same intended function (i.e. attract cats) does not patentably distinguish over the prior art of record. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Furthermore, Ford teaches that the concept of closing a pocket/opening of a pet bed is known general knowledge in the art since Ford teaches the closing elements (Ford Fig. 2 #9). The claim language is very broad in nature. Applicant hasn't claimed/defined the structure of the closure. Applicant hasn't claimed a specific physical closure mechanism. The claim states merely "closable opening" i.e. an opening that is capable of being closed.

Claims 8 and 9 are merely functional language claims that fail to further limit the independent claim since it is an apparatus claim and weight is not given to method

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steps in an apparatus claim. Ford is capable of performing the functions intended in claims 8 and 9.

Examiner maintains that applicant has not patentably distinguished over the teachings of the cited prior art.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Andrea M. Valenti/

Primary Examiner, Art Unit 3643

08 June 2010

Conferees:

Andrea M. Valenti /Andrea M. Valenti/ Primary Examiner, Art Unit 3643

Peter Poon /P. M. P./

Supervisory Patent Examiner, Art Unit 3643

Marc Jimenez /MJ/ TQAS TC 3600